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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/812,449

03/29/2004

Pauline Maria Foster-Hamilton

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EXAMINER

DUNWOODY, AARON M

ART UNIT

PAPER NUMBER

3679

DATE MAILED: 08/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/812,449	<b>Applicant(s)</b> FOSTER-HAMILTON ET AL.	
	<b>Examiner</b> Aaron M. Dunwoody	<b>Art Unit</b> 3679	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 30 May 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 12-22 is/are allowed.
- 6) ☒ Claim(s) 1-11,23-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-11 and 23-26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In regards to claim 1, there is an inconsistency between the language in the preamble and certain portions in the body of the claim, thereby making the scope of the claim unclear. The preamble in claim clearly indicates that a subcombination is being claimed, e.g., "An improved boot for use in sealing a constant velocity joint and ball spline joint assembly". This language would lead the examiner to believe that the applicant intends to claim only the subcombination of "an improved boot" the constant velocity joint and ball spline joint assembly being only functionally recited. This presents no problem as long as the body of the claim also refers to the functionally, such as, "for use in".

The problem arises when the constant velocity joint and ball spline joint assembly positively are recited within the body of the claim, such as, "the first stabilizing member selectively circumscribing an inner race of the ball joint", and "the second stabilizing member selectively circumscribing an outer race of the ball spline". There is an inconsistency within the claim; the preamble indicates subcombination, while in at least one instance in the body of the claim there is a positive recital of structure indicating that

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the combination of an improved boot, and a constant velocity joint and ball spline joint assembly are being claimed. The examiner cannot be sure if applicant's intent is to claim merely the improved boot or the improved boot in combination with the constant velocity joint and ball spline joint assembly. A similar problem is presented in claim 23.

Applicant is required to clarify what the claims are intended to be drawn to, i.e., either the improved boot alone or the combination of the improved boot, and the constant velocity joint and ball spline joint assembly. Applicant should make the language of the claim consistent with applicant's intent. In formulating a rejection on the merits, the examiner is considering that the claims are drawn to the combination and the claims will be rejected accordingly. If applicant indicates by amendment that the combination claim is the intention, the language in the preamble should be made consistent with the language in the body of the claims. If the intent is to claim the subcombination, then the body of the claims must be amended to remove positive recitation of the combination.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 23-26 are rejected under 35 U.S.C. 102(e) as being anticipated by US patent 6585602, Cermak et al.

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In regards to claim 1, as best understood, in Figure 7 below, Cermak et al an improved boot for use in sealing a high speed fixed joint and ball spline joint assembly, the boot comprising:

- a plurality of articulating convolutes adapted to accommodate joint articulation of up to approximately 15 degrees;

- a grease catching member;

- a first stabilizing member joining and contiguous with the plurality of articulating convolutes and the grease catching member, the first stabilizing member adapted to ride approximately 1 mm above an inner race of the ball joint to provide stability at high speed;

- a plurality of plunging convolutes adapted to accommodate joint plunge up to approximately 45 mm; and

- a second stabilizing member joining and contiguous with the plurality of plunging convolutes and the grease catching member, the second stabilizing member adapted to ride approximately 1 mm above an outer race of the ball spline joint to provide additional stability.

In regards to claim 24, in Figure 7, Cermak et al disclose an external diameter of the grease catching member being generally greater than external diameters of either the first stabilizing member or the second stabilizing member.

In regards to claim 25, in Figure 7, Cermak et al disclose an external diameter of the first stabilizing member being generally less than an external diameter of either the second stabilizing member of the outer race of the ball spline joint.

In regards to claim 26, in Figure 7, Cermak et al disclose a shaft portion interconnecting at least one of the constant velocity inner race and the constant velocity outer race with at least one of the outer race and the inner race of the ball spline joint.

***Allowable Subject Matter***

Claims 12-22 are allowed.

***Response to Arguments***

Applicant's arguments with respect to claims above have been considered but are moot in view of the new ground(s) of rejection.


***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aaron M. Dunwoody whose telephone number is 571-272-7080. The examiner can normally be reached on 7:30 am - 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P. Stodola can be reached on 571-272-7087. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Aaron M Dunwoody  
Primary Examiner  
Art Unit 3679

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